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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,655	05/08/2001	Ephraim Zehavi	QCPA181ACAC	4391

7590 12/17/2002
QUALCOMM Incorporated
Attn: Patent Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

NGUYEN, PHUONGCHAU BA

ART UNIT PAPER NUMBER

2665

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,655

Applicant(s)

LAROCCA ET AL.

Examiner

Phuongchau Ba Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10-9-02 RCE Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 6–10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1–5 of prior U.S. Patent No. 5,777,990. This is a double patenting rejection.

3. Claims 25–28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1–2, 6–7 of prior U.S. Patent No. 6,292,476. This is a double patenting rejection.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 11-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-5 of U.S. Patent No. 5,777,990. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims 12-15 & 17-20 merely broaden the patented claims 2-5, 11 by redrafting the dependency of patented claims 2-5 on patented claim 11 which is a system for transmitting variable rate packets of data symbols comprising a channel

packetizer, a first modulator, a first PN modulator, a second modulator, a second PN modulator, a transmitter instead of patented claim 1 which also is a system for transmitting variable rate packets of data symbols comprising channel packetizer means, first modulator means having a PN modulator, second modulator means having a PN modulator, a transmitter. Therefore, it would have been obvious to a skilled artisan to add the patented dependent claims 2-5 (as now claims 12-15, 22-24) as dependent claims to patented claim 11 and the motivation being to provide another non-identical claims set of claims 1-5.

Also, claims 17-20 are method claim, therefore, it would have been obvious to a skilled artisan to implement a teaching of an element's function in a method claim and the motivation being to provide a software implementation (e.g. software programming) of claimed elements (i.e., channel packetizer, first modulator, first PN modulator...etc. in patented claims 1 and 11) for easing the upgrade of elements.

Likewise, the application claims 11 & 21 merely broaden the patented claim 1 by redrafting the patented claim 1 (as now claims 11 & 21; i.e., the

different orthogonal code sequence in modulation means of the patented claim 1 are not being redrafted as a first and second orthogonal code sequence in the application claims 11 & 21); eliminating the name in a means (i.e., "channel packetizer" being eliminated from "channel packetizer means" in the patented claim 1; "first modulation, second modulation" being eliminated as well) and "at least one"(patented claim 1, line 20) and preamble "in code division multiple access...on a traffic channel"(patented claim 1, lines 1-5). It has been held that the omission of an element and its functions is an obvious expedient if the remaining elements perform the same function as before {In re Karlson, 136 USPQ 184 (CCPA)}.

Response to Arguments

6. Applicant's arguments filed 10-15-02 have been fully considered but they are not persuasive.

A/. Applicant argued that patents '990 and '476 recited claims in a "means plus function" format wherein application claims 6-10, 11& 21 and 25-

28 recited claims with structural limitations, thus claims should be rejected in obviousness-type double patenting not 35 USC 101.

In reply, a “means” is always recited before a “for” for doing something (functioning) accordance to the specification, e.g., means for receiving is the same as receiving means for receiving. Thus, application claims 6–10 and ‘990 patented claims 1–5 recited “channel packetizer means for receiving” is the same as “channel packetizer for receiving” in the application claims 6–10, means plus function format claims are not necessary to recited a “name” before a “means” but it can recite just a “means” or a “name” for performing a function accordance to the specification.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose telephone number is 703–305–0093. The examiner can normally be reached on Monday–Friday from 10:00 a.m. to 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Huy Vu can be reached on 703–308–6602. The fax

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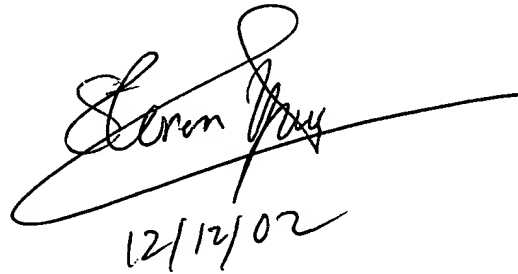
phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



Phuongchau Ba Nguyen
Examiner
Art Unit 2665

December 10, 2002



12/12/02